

REMARKS

Claims 7, 9, 12-17, 28, 29, 36, 37 and 40-110 are pending in this application. Claims 7, 9, 17, 57, 70, 79, 90 and 103 are independent claims.

By this amendment, claims 7, 9, 12-17, 28, 36, 37, 40 and 41 are amended, claims 1, 3-6, 8, 18-27, 30-35 and 38-39 are canceled without prejudice or disclaimer thereto, and new claims 42-110 are added.

Reconsideration in view of the above-noted amendments and the following remarks is respectfully solicited.

Personal Interview Scheduled for November 22, 2005

Applicants respectfully remind the Examiner that a "Personal Interview" has been scheduled for November 22, 2005 to discuss the subject matter contained herein.

The Claims Define Patentable Subject Matter

The final Office Action rejected:

(1) claims 1, 3, 5-9, 12, 13, 17, 21, 25, 29, 33, 37 and 41 under 35 U.S.C. §10a(a) as being unpatentable over U.S. Patent No. 6,727,954 to Okada (hereafter Okada) in view of U.S. Patent No. 6,683,649 (hereafter Anderson '649);

(2) claims 4, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Anderson and further in view of U.S. Patent Application Publication No. 2002/0082080 A1 to Kojima (hereafter Kojima);

(3) claim 14 under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Anderson and further in view of Japanese Patent No. JP 11218817 to Miyake (hereafter Miyake);

(4) claims 18, 22, 26, 30, 34 and 38 under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Anderson and further in view of US. Patent No. 6,559,773 to Berry (hereafter Berry); and

(5) claims 19, 20, 23, 24, 27, 28, 31, 32, 35, 36, 39 and 40 under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Anderson and further in view of to Berry and further in view of U.S. Patent No. 4,712,105 to Kohler (hereafter Kohler).

These rejections are respectfully traversed.

Applicants respectfully submit that the combination of Okada and Anderson, either alone or further in combination with Kojima and/or Miyake and/or Berry and/or Kohler, fails to teach or suggest each and every feature as set forth in the claimed invention.

Specifically, applicants respectfully submit that amended independent claims 7, 9, 17 and new independent claims 57, 70, 79, 90 and 103 include features that fail to be taught by the cited art.

For example, in independent claims 7, 9 and 17 the limitation “wherein said display displays information related to the operation mode selected by the user at the center thereof, and wherein said information related to the function assigned to said respective switch portions is presented as a symbol” is added to the respective claims. As such, according to amended claims 7, 9 and 17 the user can intuitively understand the complex functions assigned to each switch in accordance with the selected mode, since the function is represented by a symbol. The above-noted features were taken from dependent claims 26 and 26 (i.e., claims 38 and 39) (i.e., claims 34 and 35).

The Examiner concedes that both Okada and Anderson fail to teach or suggest that the display displays information related to the operation mode selected by the user at the center thereof. (see Office Action, page 16, section 8). In an attempt to show this feature, the Examiner imports Berry.

However, applicants respectfully submit that there fail to be proper motivation to combine Okada, Anderson and Berry and that the Examiner is merely relying on improper hindsight.

Applicants respectfully submit that from our review of Okada, Anderson and Berry, we find no teaching or suggestion to support the examiner’s asserted motivation to combine the references so as to “have the user aware of the menu in operation while operating the mode selected.” The examiner’s statement is unsupported because the examiner has not established

that such an awareness is even a factor recognized by Okada, Anderson and Berry. The examiner has not pointed to any showing in either reference that would suggest that such a motivation is an issue recognized in any of the references.

Applicants respectfully submit that but for applicants' own disclosure of the specific elements involved, i.e., their sizing, their number, and their interrelationship with one another, the applied references themselves would not have instructed one versed in the art on how to go about selectively reworking and modifying such devices to yield applicants' claimed invention. Accordingly, applicants submit that the Examiner's rejection is predicated upon impermissible hindsight, and not upon a suggestion from the combination of the references applied that would have been derivable by one versed in the art from the references themselves.

Applicants respectfully submit that only through impermissible hindsight reconstruction using applicants' invention would one find motivation to modify the Okada and Anderson systems to have all of the claimed features. As such, applicants submit that the Office Action has improperly used applicants' invention as a road map to pick and choose features and paste the chosen features together to arrive at the claimed invention, even though the cited references does not provide any teachings, suggestion or motivation to make the modification.

In addition, new claims 57 and 70 include the limitation "wherein said input unit is arranged on a face of said information recording apparatus that faces a user when the user uses said information recording apparatus in such a manner that said input unit is positioned at an upper portion of a center of the face on a right side of the center. Accordingly, the user can readily understand the complex functions assigned to each switch in accordance with the selected mode and at the same time, the user can easily operate the information recording apparatus (camera) with his/her thumb on his/her right hand. The above-noted feature was taken from dependent claim 14.

Similarly, as with the combination of Okada, Anderson and Berry, applicants respectfully submit that there fail to be proper motivation to combine Okada, Anderson and Miyake and that the Examiner is again merely relying on improper hindsight.

Applicants respectfully submit that from our review of Okada, Anderson and Miyake, we find no teaching or suggestion to support the examiner's asserted motivation to combine the

references so as to “enable the user to operate the camera by using only one hand, since the input device can be used while reaching the shutter button.” The examiner’s statement is unsupported because the examiner has not established that such an enablement is even a factor recognized by Okada, Anderson. The examiner has not pointed to any showing in either reference that would suggest that such a motivation is an issue recognized by Okada and/or Anderson.

In addition, new independent claims 79, 90 and 103 include the limitation “wherein said display displays information related to the operation mode selected by the user as a first icon and information related to the function assigned to said respective switch portions as a second icon, and said first icon is larger than said second icon.” Accordingly, the user can easily recognize the distinction between “mode representation” and a “function representation.”

In contrast with the present invention as set forth in independent claims 79, 90 and 103, the cited art fails to teach or suggest such a feature.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicants respectfully submit that their fail to be proper motivation for the combination of cited references and that the Examiner is merely taking individual features from several references and attempting to paste such features together to arrive at the claimed invention, based on impermissible hindsight. The Examiner’s statements of motivation are based on nothing more than hindsight reasoning.

Applicants respectfully submit that claims 7, 9, 12-17, 28, 29, 36, 36 and 40-110 are allowable over the combination of cited art for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 1, 3-9 and 12-41 under 35 U.S.C. §103(a) is respectfully requested and allowance of pending claims 7, 9, 12-17, 28, 29, 36, 37 and 40-110 are respectfully solicited.

Conclusion

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

By



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